

**PATENT**  
**Application 10/748,958**  
**Attorney Docket 2003-0010 (1014-052)**

**REMARKS**

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 1-4, 19, and 20 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-20 are now pending in this application. Each of claims 1, 19, and 20 is in independent form.

**I. Consideration of Submitted References is Requested**

On 7 March 2008, an Information Disclosure Statement and PTO Form 1449 listing and providing five references was submitted. It is respectfully requested that those references be expressly considered during the prosecution of this application, that the references be made of record therein, and appear in the "References Cited" section of any patent to issue therefrom. It is respectfully requested that the next communication from the USPTO include a copy of the Form 1449 with the Examiner's initials beside each listed reference.

**II. The "Response to Arguments"**

As a note to a "Response to Arguments" section presented at Page 8, the present Office Action erroneously asserts:

Adapted to: It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

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Capable of: It has been held that the recitation that an element is "capable of performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138

This assertion is respectfully traversed. With all due respect, *In re Hutchison* was decided 20 years prior to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) and thus, could not have used the obviousness criteria established by *Graham*. In over 60 years since *In re Hutchison* was decided, no appellate court has cited *In re Hutchison* as authority for a premise that an element adapted to perform a function is not a positive limitation in any patentable sense as asserted by the present Office Action. For at least these reasons, *In re Hutchison* is no longer valid law in view of *Graham* and subsequent case law regarding the claim phrase "adapted".

The predecessor court to the Federal Circuit has interpreted the phrase "adapted" as preceding a "structural limitation". See, *In re Venezia*, 530 F.2d 956 (CCPA 1976). Claim limitations preceded by "adapted" have been considered sufficiently definite. See MPEP 2173.05(g).

In addition, the Federal Circuit has interpreted the word "adapted" as preceding "functional language [that] limits the scope of these claims to devices that have the capability of" performing the stated function. See, *R.A.C.C. Indus., Inc. v. Stun-Tech, Inc.*, 178 F.3d 1309, 49 USPQ2d 1793 (Fed. Cir. 1998) (*cert. denied*, 526 U.S. 1098 (1999)) (cited with approval by MPEP 2106.IV.B). Because such functional language serves as a claim limitation, a reference cited to support a rejection of a claim must describe a structure(s) capable of performing each claimed function preceded by the term "adapted."

Further, in the case of *In re Land*, the CCPA ruled on a relevant claim that stated "said color-providing substances associated with at least the inner photosensitive emulsion layers are adapted to be rendered diffusible in said liquid composition only after at least substantial development of the next outermost photosensitive ... layer has occurred." See, *In re Land*, 368 F.2d 866, 151 USPQ 621, 635 (CCPA 1966). The CCPA noted that the italicized portions of the claim were functional and held the claim patentable in view of the functional limitations.

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To the extent that the present Office Action has failed to provide a proper examination of any of claims 1-20 based upon this erroneous assertion, Applicant traverses and respectfully requests a proper examination of each such claim.

### **III. The Obviousness Rejections**

Each of claims 1-20 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of International Patent Application Publication WO 01/17219 ("Hjartarson"), U.S. Patent 6,292,840 ("Blomfield-Brown"), U.S. Patent Application Publication 2004/0032860 ("Mundra"), U.S. Patent Application Publication 2005/0015259 ("Thumpudi"), U.S. Patent Application Publication 2007/0053348 ("Koistinen"), and/or U.S. Patent Application Publication 2002/0038158 ("Hashimoto"). Each of these rejections is respectfully traversed as moot in view of the present amendments to the claims.

Specifically, claim 1, from which each of claims 2-18 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "responsive to an SS7 query of a server that determines that a subscriber is an enhanced service subscriber, encoding, via high-quality audio codec instructions running on a digital signal processor installed on the subscriber interface line card, the plurality of digital samples". In addition, claim 1, from which each of claims 2-18 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "the codec instructions encoding multiple channel audio". Also, claim 1, from which each of claims 2-18 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "at least one piece of customer premises equipment exchanging network signals, to verify that a subscriber is using intelligent customer premises equipment".

Claim 2 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "wherein the high-quality audio codec instructions are compatible with G.722 and the encoded digital samples are transmitted via an ISDN BRI call that utilizes both A and B channels to provide a 127 kbps bearer channel".

Claim 3 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "wherein the high-quality audio codec instructions

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are compatible with ITU G series codecs and the subscriber interface line card provides high quality encoding/decoding for both 'on-net to on-net' calls and 'on-net to off-net' calls through interworking with ISDN for negotiation of bearer capabilities between called and calling parties".

Claim 4 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "wherein the subscriber interface line card assumes a default high-quality audio codec capability of G.722, but automatically substitutes a Dolby Digital AC-3 codec for the G.722 codec upon learning that far-end customer premises equipment can handle Dolby Digital AC-3".

Claim 19 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "responsive to an SS7 query of a server that determines that a subscriber is an enhanced service subscriber, encoding, via high-quality audio codec instructions running on a digital signal processor installed on the subscriber interface line card, the plurality of digital samples into an LD-CELP format". In addition, claim 19 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "at least one piece of customer premises equipment exchanging network signals, to verify that a subscriber is using intelligent customer premises equipment". Also, claim 19 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "the subscriber interface line card adapted to pass the plurality of digital samples to an ATM Utopia bus".

Specifically, claim 20 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "a high-quality audio codec installed on the subscriber interface line card, adapted to run on a digital signal processor coupled to the POTS subscriber interface line card, and adapted to, responsive to an SS7 query of a server that determines that a subscriber is an enhanced service subscriber, encode the plurality of digital samples into an LD-CELP format". In addition, claim 20 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "at least one piece of customer premises equipment exchanging network signals, to verify that a subscriber is using intelligent customer premises equipment". Also, claim 20 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon

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references teach, "the subscriber interface line card adapted to pass the plurality of digital samples to an ATM Utopia bus".

For at least this reason, it is respectfully submitted that the rejection of each of claims 1-4, 19, and 20 is unsupported by the applied portions of the relied-upon references and should be withdrawn. Also, the rejection of claims 2-18, each ultimately depending from one independent claim 1, is unsupported by the applied portions of the relied-upon references and also should be withdrawn.

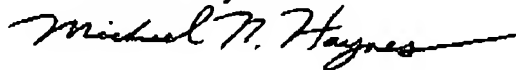
**CONCLUSION**

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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